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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,175	10/24/2000	Alirio I. Gomez	02012-40121	2823

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EXAMINER

JUNG, DAVID YIUK

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/695,175

Applicant(s)

GOMEZ

Examiner

David Y. Jung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

CLAIMS PRESENTED

Claims 1-24 are presented.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. The prior art rejection involving the Webfeat reference has been withdrawn.

Some of the applicant's arguments regarding the references are correct

Applicant is thanked for kind assistance on some matters. Some of the arguments were persuasive – thus leading to new grounds of rejections. Some of the other arguments were helpful in understanding the Applicant's position – even if not yet deemed to be persuasive. The other arguments bring some concern. Thus, the following are noted.

Some of the applicant's arguments regarding dates of references are incorrect

Surely, Applicant's position is that he is of some knowledge in the art; perhaps, Applicant may even position himself as that of above-ordinary skill in the art. And yet, on page 10 of the Amendment (the first paragraph), Applicant's attorney wrote: "The Examiner asserts that some references do not need dates. (Telephonic Interview with Jennifer Overly, April 28, 2005). Applicants respectfully disagree." Page 10 goes on to

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quote MPEP 2128.01 which, of course, refers to publication date. The purpose of this portion of MPEP was to date the reference. On the issue of date, Applicant's attorney was told that MSDN refers to Microsoft Developer Network. Thus, Applicant's attorney was told that the only way the date can be disputed would be to dispute whether the Microsoft Developer Network disclosed the cited features before the filing date of this patent application. And yet, instead of disputing whether the Microsoft Developer Network disclosed the cited features before the filing date of this patent application, Applicant's attorney chose to focus on "publication date" of the printout of this reference. Applicant's attorney refused to acknowledge even the personal knowledge of the influence of Microsoft Developer Network. Is not Microsoft Developer Network well known to those of ordinary skill in the art? Even if Applicant's attorney did not actually know of Microsoft Developer Network (which the Office cannot be sure) at the time of the Telephone Interview, Applicant's attorney had reason to discuss this with the Applicant (at the minimum, in order to check into the veracity of the Examiner's assertions). And yet, instead of disputing whether the Microsoft Developer Network disclosed the cited features before the filing date of this patent application, Applicant's attorney chose to focus on "publication date" of the printout of this reference. Thus, the arguments bring some concern. If the Examiner does not specifically mention and discuss frivolous arguments, then the record may indicate that the Examiner may not have recognized these arguments as frivolous. After allowance, the impression of the reader of the patent would be that the Examiner was influenced by the frivolous arguments. This would not help in sustaining the assumption of validity. Furthermore,

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penalties regarding frivolous arguments can be stronger in patent cases than in other cases. Indeed, the current statutes of patent laws do not stop at common law standard for award of interest which provided that prejudgment interest could not be awarded where damages were unliquidated absent bad faith or other exceptional circumstances. General Motors Corporation v. Devex Corporation et al. (US SupCt) 217 USPQ 1185 (1983). For these reasons, the Examiner is forced to note the arguments that seem to be frivolous.

Applicant's substantive arguments regarding the art are incorrect

At page 11, Applicant stated: "the limitation of the reference [is] that only one window station can be interactive. The claimed methods and systems, on the other hand, are not limited." First, is it true that only one window station can be interactive? The cited passage "Only one window station can be interactive" in the first paragraph of the reference refers to one window station per service. For multiple services (each of which can be copies of the others), there can be multiple window stations. This merely refers to the common type of architecture used in event driven systems. This is well known in the art. The Office is unaware of anyone purporting to be one of ordinary skilled in the art that refuses to acknowledge the knowledge regarding this matter. Second, which portions of the claims provide for multiply interactive situation? This is important because the Office needs to know the exact nature of the meaning of the claims as intended by Applicant. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the

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features upon which applicant relies (i.e., such multiply interactive situation) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

At page 11, Applicant argued that Hoyt et al. does not teach the features noted at page 11. And yet, the Office Action did not state that Hoyt et al. was relied to teach such features. Thus, the arguments are inapplicable.

At pages 11-13, Applicant argued that the Examiner had relied on Official Notice. Furthermore, Applicant argued that such Official Notice would be inappropriate. For this to be true, Applicant must explicitly state that Applicant sincerely does not know of such facts to be of "instant and unquestionable" (Applicant's words). Is this true? Does the Applicant assert that the Applicant does not understand the subject matter to be known to those of ordinary skill in the art? Does the Applicant assert that the Applicant does not understand the subject matter himself? Yet, in the discussion that extends through pages 11-13, not one individual claim was discussed. Instead, Applicant merely repeated the Office Action and stated that the Office Action was wrong. Nowhere does the Applicant go beyond repeating the Office Action. This is tantamount to Applicant refusing to acknowledge that Applicant understands the subject matter of the claims. Does the Applicant assert that these facts are not "instant and unquestionable" to those of ordinary skill in the art? Surely, Applicant would not assert so. Thus, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general

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allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments regarding Webfeat reference is correct

Applicant did have a valid point in correcting the Office regarding the Webfeat reference. Applicant stated: "Examiner relies on a statement in a separate article located at <http://www.libraryjournal.com> ... to date the Webfeat knowledge prism to 1998 ... However, nothing on the Library Journal webpage identifies either what occurred in 1998 or identifies the date the Webfeat system was either invented, published, or otherwise made available to the public." Thus, the issue is that of the date of the Webfeat system being made public. Applicant notes that the date of the public knowledge cannot be traced from this cited reference. Applicant is thanked for this kind assistance.

CLAIM REJECTIONS

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

At page 11 of the outstanding Response, Applicant stated: "the limitation of the reference [is] that only one window station can be interactive. The claimed methods and systems, on the other hand, are not limited." Applicant did not provide any actual claim language. After a careful study, the Office noted the language "at least one user

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computer” and “at least one content provider.” Applicant clearly refers to this language to provide such meaning. Thus, the claims are now interpreted on this basis.

Therefore, a new rejection – under 35 USC 112 – is given. The term “at least one” (e.g., computer) in claims is used by the claim to not mean “one”, while the accepted meaning is to mean “one” as well as “more than one.” The term is indefinite because the specification does not clearly redefine the term. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

Conclusion

The art made of record and not relied upon is considered pertinent to applicant's disclosure. The art disclosed general background.

Because Applicant's Response showed that the previous Office Action was improperly made final, the **finality of the previous Office Action is withdrawn.**

Applicant's Response necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Points of Contact

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 746-7239, (for formal communications intended for entry)

Or:

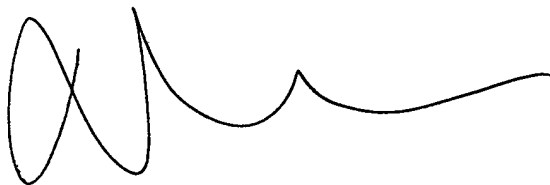
(703) 746-5606 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Jung whose telephone number is (571) 272-3836 or Greg Morse whose telephone number is (571) 272-3838.

David Jung

Patent Examiner

7/31/05

A handwritten signature in black ink, consisting of a large, stylized 'D' followed by a series of loops and a long horizontal stroke.